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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,128	03/16/2004	Michael Grasso III	09423.0042-02000	9136
22852	7590	10/17/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER GIBSON, ROY DEAN	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,128

Applicant(s)

GRASSO ET AL.

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35,52-57 and 61 is/are rejected.
- 7) ☐ Claim(s) 36-51,58-60 and 62-66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/19/2004.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 53, 54 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (6,068,603). Suzuki discloses a medical device comprising:

a suction conduit (Figure 11B, # 12) capable of removing material from a body lumen and configured to provide suction at a distal region of the medical device;

an elongated housing (9) having a plurality of channels (14 and 91) extending along the medical device and radially separated from the suction conduit;

at least one energy transmitting conduit (14 with a snare that is attached to a HF generator, typically RF) housed within one of the plurality of channels and configured to transmit energy capable of fragmenting, coagulating, or vaporizing material in a body lumen, at least a portion of energy transmitted being directed towards a distal region of the suction conduit (the electromagnetic field surrounding the snare extends toward the distal region of the suction conduit), and wherein one of the plurality of channels is an irrigation channel (91) which transfers a cooling agent from an irrigation source

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(Figure 11, col. 1, line 66-col. 2, line 11, col. 5, line 60-col. 7, line 53, col. 11, lines 4-7 and col. 13, line 44-col. 14, line 19).

Claims 35, 52, 53, 57 and 61 are also rejected under 35 U.S.C. 102(e) as being anticipated by Davison et al. (6,296,638).

As to claims 35 and 52, Davison et al. disclose a medical device comprising:
a suction conduit (Figure 9, # 609) capable of removing material from a body lumen and configured to provide suction at a distal region of the medical device;
an energy transmitting conduit (the conduits for the lead wires for electrode 540) configured to transmit energy (RF) capable of fragmenting, coagulating, or vaporizing material in a body lumen, at least a portion of energy transmitted being directed towards a distal region of the suction conduit (the electromagnetic field surrounding the electrode extends toward the distal region of the suction conduit);
a barrier positioned outside a distal end of the suction conduit) the second electrode across the opening of the suction conduit) such that a gap is formed between the barrier and the distal end of the suction conduit;
wherein the size of the gap is inherently configured to limit the size of objects removed through the suction conduit (col. 24, line 25-col. 26, line 46 and col. 29, lines 19-50).

As to claims 53, 57 and 61, Davison et al. disclose a medical device comprising:
a suction conduit (Figure 9, # 609) capable of removing material from a body lumen and configured to provide suction at a distal region of the medical device;

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an elongated housing (500) having a plurality of channels (Figure 9) extending along the medical device and radially separated from the suction conduit;

at least one energy transmitting conduit (Figure 11 with an electrode (540) that is attached to a HF generator, typically RF) housed within one of the plurality of channels and configured to transmit energy capable of fragmenting, coagulating, or vaporizing material in a body lumen, at least a portion of energy transmitted being directed towards a distal region of the suction conduit (the electromagnetic field surrounding the electrode extends toward the distal region of the suction conduit), comprising multiple energy transmitting conduits each conduit housed within a separate channel of the plurality of channels of the medical device (col. 24, line 25-col. 26, line 46 and col. 29, lines 19-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davison et al. Davison et al. disclose one channel for a pullwire configured to enable deflection of the distal end of the medical device, but not two wires or a channel for a guidewire (Figure 8 and col. 23, lines 21-33). However, the examiner maintains

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that the medical arts is replete with examples of a two wire configuration for pullwires and for lumens for guide wires to position the device internally in the body of the patient. Therefore, it would have been obvious at the time of the invention to modify the device of Davison et al. to include a second channel for a pullwire and a channel for a guidewire.

Allowable Subject Matter

Claims 36-51, 58-60 and 62-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

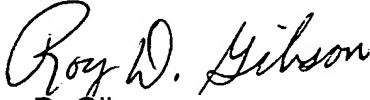
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hakky et al. (5,312,399) disclose a laser resectoscope with a mechanical cutting means and laser coagulation means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on Tu-Th, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Roy D. Gibson
Primary Examiner
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October 12, 2005